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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,676	06/30/2000	Warren Keith Edwards	XERX-01041US0 MCF/JEF	1239
23910	7590	02/21/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/607,676	Applicant(s) EDWARDS ET AL.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,25 and 62-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,25 and 62-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed on 12/1/2005.

This action is made Final.

2. In the amendment, claims 1-11, 13-24, and 26-61 have been canceled. Claims 12, 25, 62-70 are pending in the case. Claim 12 is an independent claim.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 120, where this application is a continuation in part of 09143802, 09143551, 09144231, 09143777, 09143772, 09144032, 09143778, 09144143, 09143555, 09144383, 09143773 to 8/31/98 is acknowledged.

Drawings

4. The drawings filed on 11/21/2002 have been accepted by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25, and 62-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 25 recites the limitation "the bit provider" in line 2. There is insufficient antecedent basis for this limitation in the claim or its base independent claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 12, 25, 62-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Danknick et al, hereinafter Danknick (Pat.# 5,901,286, 5/4/1999, filed on 11/15/1996).

Regarding independent claim 12, Danknick teaches an SNMP client, which obtains copier—*entity--* configuration settings-- *associated property--* from an SNMP agent-- *data source--*. In other words, the client identifies, not the user—*independent of specific user request associating the associated property and the data source--*, that the agent has the configuration settings requested—*identifying the data source--* (col.7, lines 14-20, fig.7-9).

Furthermore, Danknick discloses the obtaining of the copier configuration parameters, and inserting, and displaying these parameters into a web page—*retrieving the content information from the data source, and providing it to define the web page document* (col.7, lines 14-20, fig.7-9). An applet is used for displaying the configuration settings within corresponding

document fields. In other words, the applet transform the display behavior of the document with the use of the settings--*further wherein at least one of said properties is an active property having associated executable code that affects the behavior of the document within the document management system.*

Regarding claim 25, which depends on claim 24, Danknick teaches inputting a request for a web page into an icon displayed on a browser, and sending the request to a copier for retrieving setting information from the copier over a network—*receiving and sending additional information from the application via a communications path--*. An SNMP client sends the request to an SNMP agent—*bit provider--*, which then retrieves requested information, and sends it to the client, where it is displayed as a web page on a window interface of the web browser--*an application interface in communication with the bit provider, the application interface configured to provide the document to an application; modify the document representing the entity* (col.6, line 49-col.7, line 30, fig.10).

Regarding claim 62, which depends on claims 12 or 25, Danknick discloses the obtaining of the copier administration—*task--* parameters, and inserting, and displaying these parameters into a web page (col.7, lines 14-20, fig.7-9).

Regarding claim 63, which depends on claim 12 or 25, Danknick teaches the inserting, and displaying obtained contact person information into an html web page – *the entity is a person --* (col.13, lines 49-67, fig.19).

Regarding claim 64, which depends on claims 12 or 25, Danknick discloses the obtaining of the copier—*object*-- configuration parameters, and inserting, and displaying these parameters into a web page— (col.7, lines 14-20, fig.7-10).

Regarding claim 65, which depends on claims 12 or 25, Danknick discloses the obtaining of the copier—*device*-- configuration parameters, and inserting, and displaying these parameters into a web page— (col.7, lines 14-20, fig.7-9).

Regarding claim 66, which depends on claims 12 or 25, Danknick discloses the obtaining the copier configuration parameters, and inserting, and displaying these parameters from data found in a web page—*document* — (col.7, lines 14-20, fig.7-9).

Regarding claim 67, which depends on claims 12 or 25, Danknick discloses the obtaining the copier configuration parameters from a server—*data source is a device* —, and inserting, and displaying these parameters into a web page (col.7, lines 14-20, fig.7-9).

Regarding claim 68, which depends on claim 67, Danknick teaches the retrieval of copier information, such as a person's phone number, through a browser (col.7, lines 1-30, col.13, lines 45-49, fig. 19).

Regarding claim 69, which depends on claim 67, Danknick discloses the obtaining the copier-- *the device is a printer*-- configuration parameters, and inserting, and displaying these parameters from data found in a web page—*document* — (col.7, lines 14-20, fig.7-9).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danknick, in view of Vertelney et al, hereinafter Vertelney (Pat. # 5,341,293, 8/23/1994).

Regarding claim 70, which depends on claim 67, Danknick teaches the retrieval of peripheral, such as a copier, information through a browser (col. 6, lines 21-40, col.7, lines 1-30). Vertelney discloses allowing a user to view, and mark photographs (col. 11, lines 35-67, fig. 6b). Danknick fails to explicitly disclose: *the device is a camera*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Danknick, and Vertelney to have a camera be represented by a document, because Vertelney teaches the advantage of permitting a user(s) to mark, find, organize, and process data within documents, and enhancing a document intuitiveness through the use of graphical elements (col. 3, lines 52-67, col. 6, lines 1-10). This would enable a user to utilize a camera element in

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the document to represent a camera which takes a picture to mark and process according to Vertelney's invention above.

Response to Arguments

12. Applicant's arguments filed 12/1/2005 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "application as are now recited and claimed in every pending claim. As stated, **these active properties have executable code** which either alters the documents or otherwise affects the documents' behavior within the document management system. Such active properties are not contemplated by Danknick" page 7, parag. 1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 12 recites "an active property having associated executable code" lines 11/12. Here the code is associated with the properties. This is not the same as the properties having within them the executable code.

Regarding claim 25, Applicants indicate that Danknick has no need to edit a document feature using an outside application (page 7, parag.2). The Examiner disagrees, because Danknick teaches inputting a request for a web page into an icon displayed on a browser, and sending the request to a copier for retrieving setting information from the copier over a network—*receiving and sending additional information from the application via a*

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communications path--. An SNMP client sends the request to an SNMP agent—*bit provider--*, which then retrieves requested information, and sends it to the client, where it is displayed as a web page on a window interface of the web browser--*an application interface in communication with the bit provider, the application interface configured to provide the document to an application; modify the document representing the entity* (col.6, line 49-col.7, line 30, fig.10).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
2/16/06